UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,151	03/06/2000	Manuel Zahariev	P3001D1	7821

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EXAMINER
DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/519,151	ZAHARIEV, MANUEL
Office Action Summary	Examiner	Art Unit	
	Larry D Donaghue	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-29* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03/06/2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

1.   Claims 1-13 and 15-29 are presented for examination.

2.   Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive

and, therefore, the finality of that action is withdrawn.

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1, 2, 5-6, 9-10,13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al.

(5,742,905).

Pepe et al. taught the invention (claim 1) as claimed, a server (40) connected to a network; and a Mail Alert

code set resident and operable on the server, wherein the Mail Alert code set is adapted to compare characteristics

of e-mail messages received for the subscriber to specific message characteristics provided by the subscriber and

pre-stored on the server (col. 4, line 56- col. 5, line 9; col. 7, line 3-15), to alert the subscriber when a characteristic

match is found, and to execute instructions from the subscriber for forwarding of the message received for which a

match was found (col. 34, lines 59-65; col. 4, line 56-67 and fig 35-39).

As to claim 2, Pepe et al. taught the subscriber is alerted on finding a characteristic match by sending a

page to a paging device carried by the subscriber (col. 5, lines 60-67).

Pepe et al. taught the invention (claim 5) as claimed, an e-mail system (40) adapted for receiving and

forwarding e-mail; and a Mail Alert system adapted to compare characteristics of e-mail messages received for the

subscriber to specific message characteristics provided by the subscriber and pre-stored on the server (col. 4, line

56- col. 5, line 9; col. 7, line 3-15), to alert the subscriber when a characteristic match is found, and to execute

instructions from the subscriber for forwarding of the message received for which a match was found (col. 34, lines

60-65; col. 4, line 56-67 and fig 35-39).

5.   As to claim 6, Pepe et al. taught the invention the subscriber is alerted on finding a characteristic match by sending a page to a paging device carried by the subscriber (col. 5, lines 60-67).

6.   As to claim 9, Pepe et al. taught prerecording on a mail server characteristics for messages to be routed, the characteristics provided by a subscriber; receiving messages addressed to the subscriber at the mail server; comparing characteristics of messages received to the prerecorded characteristics provided by the subscriber (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); identifying and storing on the mail server messages received for the subscriber for which a match is found to the prerecorded characteristics (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); alerting the subscriber to the receipt of one or more messages for which a characteristic match is found (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); and forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert (col. 19, line 30- col. 20, line 25).

7.   As to claim 10, Pepe et al. taught wherein, in the alerting step, a page is sent to a pager carried by the subscriber to alert the subscriber to the receipt of the one or more messages (col. 5, lines 60-67).

8.   As to claim 13, Pepe et al. taught agent for processing e-mail messages, comprising: a stored list of message characteristics provided by a subscriber; a receiver adapted for receiving e-mail messages and ascertaining message characteristics of the received messages (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); a comparator adapted for comparing characteristics of received messages with stored characteristics, and tagging those messages wherein the characteristics match (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); an alert mechanism for alerting a subscriber to the receipt of messages having characteristics matching the stored characteristics (col. 4, line 56- col. 5, line 9; col. 7, line 3-15),; and a save facility adapted for storing matched messages against future distribution instructions (col. 19, line 30- col. 20, line 25).

As to claim 15, Pepe et al. taught the alert mechanism comprises a page transmitter adapted for transmitting a page signal to a pager carried by the subscriber (col. 5, lines 60-67).

9.   Claims 4, 8,11 and 17 are rejected under 35 U.S.C. 103(a) as applied to claims 1, 2, and 5-6 as being unpatentable over Pepe et al. (5,742,905).

10.   Pepe et al. did not expressly disclose the use of the automated telephone menu for responding to the alert. Pepe et al. did disclose the use of a telephone menu (col. 11, lines 14-32) and Pepe et al. discloses the use of cross media notification and performing the redirection in real time (col. 20, line 42 - col. 21, line 53). Pepe et al. taught that the system is for operating with mobile equipment such as PDA, pager and cellular phone (col. 5, lines 56-67). It would have been obvious to one of ordinary skill in the art at the time of the invention in view of the cited teachings

that an automated telephone menu for responding to the alert would have been an obvious modification, as Pepe et al. expressly disclosed that the media and format for delivery is selectable by the subscriber (col. 6, lines 1-19).

11.   Claims 3, 7, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al. (5,742,905) as applied to claims , above, and further in view of Fuller et al. (6,545,589).

Pepe et al. did not expressly disclose the involvement of an operator in the system, Fuller et al. taught the use of operator in a menu system to aid the user (col. 46, lines 12-30). It would have been obvious to one of ordinary skill in the data processing art at the time of the invention to allow for operator assists to aid the user in directing the calls.

12.   Claims 19-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al. (5,742,905).

As to claim 19, Pepe et al. taught receiving a message for a subscriber (at least col. 29, lines 42- col. 30, line 13); comparing the message to criteria (at least col. 29, line 41- col. 30, line 13, figures 38 and 39); if the message matches the criteria (col. 29, lines 41-46, figures 38 and 39), then sending an alert to the subscriber (col. 29, line 42- col. 30, line 13, figures 38 and 39); receiving a reply from the subscriber in response to the alert, the reply comprising instructions for the message; and processing the message according to the instructions (col. 29, line 47- col. 30, line 13).

As to claim 20, Pepe et al. taught the message is an email message (col. 20, lines 13-53) .

As to claim 21, Pepe et al. taught the alert is a notification message that identifies the received message and criteria matching the message (col. 20, lines 13-53).

As to claim 22, Pepe et al. taught the comparing step comprises filtering the message to determine if parts of the message meet the criteria (col. 4, line 56- col. 5, line 9; col. 7, line 3-15).

As to claim 23, Pepe et al. taught the criteria are selected from the group consisting of message sender information; message subject line information; message body information; and message attachment information.

The claim is in the alternative, see (col. 29, line 42- col. 30, line 13, figures 38 and 39).

As to claim 24, Pepe et al. taught wherein the alert comprises at least a portion of the message (col. 20, lines 42-57).

As to claim 25, Pepe et al. taught the alert is a message sent to a pager (col. 23, line 63 -- col. , line 13).

As to claim 26, Pepe et al. taught wherein the alert is a message sent to a phone (32,26).

As to claim 27, Pepe et al. taught the instructions comprise a command to forward the message to a new destination (col. 29, line 47- col. 30, line 13).

As to claim 28, Pepe et al. taught the new destination is selected from the group consisting of an e-mail address; a fax number; a telephone number; a hand-held computer; a notebook computer; a server computer; and an Internet Service Provider (ISP) (col. 29, line 47-col. 30, line 13, figure 3, 22, 48, 32, 24, 34).

As to claim 29, Pepe et al. taught wherein the reply is received via an entity selected from the group consisting of an operator; a voice-response system; a telephone call; an auto attendant; and a two-way pager.

The claim is in the alternative Pepe et al. taught at least the use of a phone (32,26).

13.   **Applicant's following arguments filed 05/07/2004 have been fully considered but they are not persuasive.**

14.   The applicant argues, "To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co., 9* U.S.P.Q.2d *1913* (Fed. Cir. *1989)).*

Claims 1 and 5 require the element "adapted . . . to alert the subscriber when a characteristic match is found." This feature is not taught by the Pepe reference. The cited sections of Pepe (i.e. columns 4 and 34 listed in Office Action paragraph 4) disclose that an alert notification is sent for all e-mail messages. Instead of teaching that a subscriber is alerted when "a characteristic match is found," Pepe teaches notification for all messages and does not include any disclosure of distinguishing among messages before sending a notification.

In paragraph 14 of the present Office Action, the Examiner has further cited column 26, line 65 through column 27, line 5 of Pepe as teaching this feature. However, the cited passage only describes matching the subject field of an e-mail to a screening list. Pepe does not teach that this matching function is coupled to an alert or notification feature as required in claims 1 and 5."

In Response

Examiner disagrees with the assertion of applicant , as the use of the matching function coupled to notification feature is taught by Pepe . See col. 10, lines 55-65 and col. 38, lines 53-55; set forth that the notification is directed on the basis of a match function (e.g. screening). Further note section C, of applicant's instant response, where the Applicant states "The Pepe reference teaches that

when an email is received, the PCI server checks the subscriber's profile, and then directs the delivery and notification according to the profile." Therefore applicant expressly state that Pepe teaches the alleged missing element.

15.   The applicant argues "Furthermore, in paragraph 15 of the Office Action, the Examiner appears to admit that Pepe does not teach this alert feature."

In Response

The cited paragraph is a statement of the applicant not the examiner. See Applicant's response, page 10, filed 12/04/2003.

16.   Applicant argues "Dependent claims 2 and 6 each depend directly from respective independent claims 1 and 5 and, thus, inherit all the limitations of the respective independent claims. Accordingly, because of their dependence from base claims I and 5, dependent claims 2 and 6 are allowable at least for the reasons discussed above."

In Response

Applicant was failed to present arguments directed to any of the limitation of the dependent claims and the rejection is maintained for the reasons set forth in the response, supra.

17.   Claim 9 requires "forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert." Pepe does not teach the above-recited feature of claim 9.

The Pepe reference teaches that when an email is received, the PCI server checks the subscriber's profile, and then directs the delivery and notification according to the profile. See Pepe, col. 25, lines 60-67. Pepe does not teach "forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert," as required by claim 9. E-mail delivery in Pepe is not done in response to an alert. Instead, email delivery is performed according to preselected criteria. The use of "preselected criteria" does not disclose the "in response to an alert" feature. Therefore, Pepe does not teach each and every element of claim 9.

In Response

This feature is expressly taught by Pepe et al. (col. 19, line 30 – col. 20, line 12; col. 20, line 42-53; col. 29, line 27-col. 30, line 13).

18.   Applicant argues claim 9 requires "alerting the subscriber to the receipt of one or more messages for which a characteristic match is found." Pepe does not teach this feature of claim 9.

In Response

Examiner disagrees with the assertion of applicant , as the use of the matching function coupled to notification feature is taught by Pepe . See col. 10, lines 55-65 and col. 38, lines 53-55; set forth that the notification is directed on the basis of a match function (e.g. screening). Further note section C, of applicant's instant response, where the Applicant states "The Pepe reference teaches that when an email is received, the PCI server checks the subscriber's profile, and then directs the delivery and notification according to the profile." Therefore applicant expressly states that Pepe teaches the alleged missing element.

19.   Applicant argues Pepe reference discloses a notification that an email has been received - without regard for a characteristic match. Therefore, Pepe does not teach each and every element of claim 9.

In Response

Examiner disagrees with the assertion of applicant , as the use of the matching function coupled to notification feature is taught by Pepe . See col. 10, lines 55-65 and col. 38, lines 53-55; set forth that the notification is directed on the basis of a match function (e.g. screening). Further note section C, of applicant's instant response, where the Applicant states "The Pepe reference teaches that when an email is received, the PCI server checks the subscriber's profile, and then directs the delivery and notification according to the profile."

20.   Applicant argues that "Claims 10-12 depend directly from independent claim 9 and, thus, inherit all the limitations of claim 9. Accordingly, dependent claims 10-12 are allowable at least for the reasons discussed above."

In Response

Applicant was failed to present arguments directed to any of the limitation of the dependent claims and the rejection is maintained for the reasons set forth in the response, supra.

21.   Claim 13 requires "an alert mechanism for alerting a subscriber to the receipt of messages having characteristics matching the stored characteristics." Pepe does not teach this feature of claim 13.

As discussed above, Pepe teaches a notification that an email has been received, but does not teach that he notification is associated with or triggered by characteristic matching. Thus, Pepe does not teach each and every element of claim 13.

In Response

Examiner disagrees with the assertion of applicant , as the use of the matching function coupled to notification feature is taught by Pepe . See col. 10, lines 55-65 and col. 38, lines 53-55; set

forth that the notification is directed on the basis of a match function (e.g. screening). Further note

section C, of applicant's instant response, where the Applicant states "The Pepe reference teaches that

when an email is received, the PCI server checks the subscriber's profile, and then directs the delivery

and notification according to the profile." Therefore applicant expressly state that Pepe teaches the

alleged missing element.

22.   Claims 15-18 depend directly from independent claim 13 and, thus, inherit all the limitations of claim 13.

Accordingly, dependent claims 15-18 are allowable at least for the reasons discussed above. Applicant

respectfully requests that the rejection of claims 13, 15-18 be withdrawn and those claims passed to issue.

        In Response
        Applicant was failed to present arguments directed to any of the limitation of the dependent claims
and the rejection is maintained for the reasons set forth in the response, supra.

23.   Applicant argues, Pepe does not teach all of the elements of claims 1, 5, 9, and 13. Dependent claims 4,

8, 11, and 18 depend either directly or indirectly from respective base claims 1, 5, 9, and 13 and, therefore, inherit

all of the limitations of their respective base claims. Therefore, Pepe does not teach or suggest all of the

limitations of dependent claims 4, 8, 12, and 18. Accordingly, dependent claims 4, 8, 12, and 18 are allowable at

least because of their dependence from respective base claims 1, 5, 9, and 13 for the reasons discussed above.

        In Response
        Applicant was failed to present arguments directed to any of the limitation of the dependent claims
(claims 4, 8, 11 and 18) and the rejection is maintained for the reasons set forth in the response, supra.

24.   The Examiner does not rely on Fuller to teach or suggest the limitations of claims 1, 5, 9 and 13 that are

missing in Pepe. Fuller discloses a system and method to manage a phone call and does not teach or suggest the

limitations missing from the independent claims. Thus, the cited combination of Pepe and Fuller does not teach or

suggest all claim limitations of claims 3, 7, 12, and 17.

        In Response
        Applicant was failed to present arguments directed to any of the limitation of the dependent claims
(claims 3, 7, 12 and 17)   and the rejection is maintained for the reasons set forth in the response, supra.

25.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
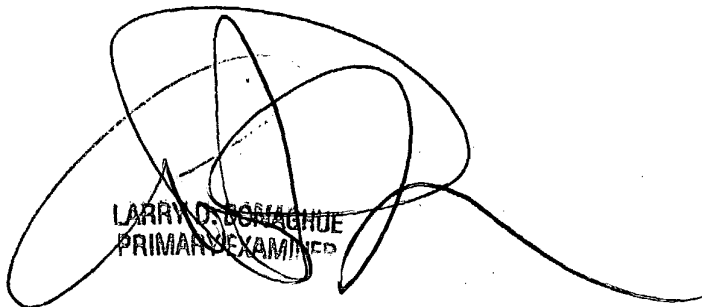
        Mulligan et al.   5,937,161

       Rogers et al.   5,946,386

26.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Donaghue whose telephone number is 703-305-9675. The examiner can normally be reached on M-F 8:00-5:00.

     If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

     Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER